

REMARKS

Claims 1, 6, 8 to 10 and 13 presented with applicants' paper of November 04, 2009, are currently pending, Claims 2 to 5, 7, 11, 12 and 14 to 21 are canceled. No claims are withdrawn or stand objected to. However,

- a) Claim 1, 8 and 9 stand rejected under 35 U.S.C. §102(a) as being anticipated by the teaching of *Girke et al.* (Plant J. 15(1), 39-48 (July 27, 1998));
- b) Claims 6 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Girke et al.* (Plant J.) when taken in view of the disclosure of *Napier et al.* (Curr. Op. Plant Biol. 2, 123-127 (April 1999));
- c) Claims 1, 8, 9 and 13 stand rejected under 35 U.S.C. §102(a) as being anticipated by the Thesis of *Girke*;
- d) Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable by a *Submission of Girke et al.* reflected in a SCORE Report enclosed with the Office action; and
- e) Claims 1, 6, 8 to 10 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Reddy et al.* (Nat. Biotech. 14, 639-642 (1996)) when taken in view of the *Submission of Girke*.

Applicants respectfully assert that the claimed subject matter is patentable under the provisions referenced above, and respectfully request that the rejections be withdrawn. As evidenced by the enclosed Declaration of Prof. Heinz, "*each disclosure of the embodiments which relate to the subject matter disclosed and claimed in U.S. Application Serial No. 10/019,048 which was made in*

- *the publication "Identification of a novel $\Delta 6$ -acyl group desaturase by targeted gene disruption in *Physcomitrella patens*", which was published on July 27, 1998, in *The Plant Journal* 15(1), 39-48 (1998);*
- *the Doctoral Thesis entitled "Functional characterization of a novel desaturase from *Physcomitrella patens* (Hedw.) B.S.G." which was publicly available not before September 03, 1998; and*
- *the Direct Submission designated as Reference 2 in the "SCORE Search Result Details ..." which was publicly available not before September 03, 1998;"*

was made by Prof. Heinz and/or by his co-inventor Dr. Girke, and that each such disclosure was made on their own behalf and on behalf of their co-inventors.¹⁾ Accordingly, since the application

1) Prof. Heinz's Declaration No. 9; emphasis added; copy enclosed.

is entitled to the filing date of application Serial. No. 09/347,531, filed on July 06, 1999,

- 1) the teaching of *Girke et al.* (Plant J. 15(1), 39–48 (July 27, 1998)), published on July 27, 1998, upon which the rejections in (a) and (b) rely does not fall within the realm of prior art under Section 102(a) because the invention was NOT “*known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by*” applicants;
- 2) the Thesis of *Girke*, published September 03, 1998, upon which the rejection in (c) relies does not fall within the realm of prior art under Section 102(a) because the invention was NOT “*known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by*” applicants; and
- 3) the Submission of *Girke et al.*, publicly available not before September 03, 1998, upon which the rejections in (d) and (e) rely does not fall within the realm of prior art under Section 102(b) because the invention was NOT “*patented or described in a printed publication in this or a foreign country ..., more than one year prior to the date of the application for patent in the United States.*”

Therefore, and for the reasons previously presented by applicants, it is respectfully requested that the rejections in (a) through (e) be withdrawn. Favorable action is respectfully solicited.

In light of the foregoing and the attached, the application is deemed to be in good condition for allowance. Early action is respectfully solicited.